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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,565

12/20/2004

Andreas Goeke

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6786

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,565	Applicant(s) GOEKE, ANDREAS	
	Examiner Joseph D. Anthony	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 7-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/20/04 and 2/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 2-3 and 7-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of formula I, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/25/08. Please note that claim 7 is being withdrawn since it is dependent on both claim 4 and claim 2, and claim 2 was not elected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by
Chemical Abstract AN. # 1995:818045 CAPLUS or Chemical Abstract AN. #
2000:184161 CAPLUS or Chemical Abstract AN. # 1984:610054 CAPLUS.

The 1995:818045 CAPLUS abstract teaches a compound of tricyclo [3.2.1]octan-2-one, 1,8,8-trimethyl whereas CAPLUS Abstract 2000:184161 teaches a compound of tricyclo [3.2.1]octan-6-one, 3,3,5-trimethyl and the CAPLUS Abstract 1984:610054 teaches a compound of tricyclo [3.2.1]octan-2-one, 1,8,8-trimethyl.

Claims 4-5 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chemical Abstract AN. # 1995:818045 CAPLUS or Chemical Abstract AN. # 2000:184161 CAPLUS or Chemical Abstract AN. # 1984:610054 CAPLUS.

The said abstracts have been described above and differ from applicant's invention in the following ways: 1) they do not directly teach (i.e. by way of a specific example) a compound that falls within applicant's claimed compounds of claims 4-5, 2) it is unclear the exact synthesis processes used to make said compounds as claimed in claims 15-16, and 3) there is not a direct disclosure to the use of said compounds to make flavor or fragrance compositions as set forth in claims 12-14.

It would have been obvious to one having ordinary skill in the art to use the disclosures of the references from which the said Chemical Abstracts were taken as additional motivation to make compounds that fall within applicant's claimed compounds, and to make these by a method that reads on applicant's claimed method. The use of ketones in flavor or fragrance compositions is deemed to be at once envisaged since these types of ketones are well known in the art to be highly aromatic, and ketones in general are well known fragrances.

Claims 1, 4-6 and 15-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over applicant cited Article XP-002254318 entitled: *Regiochemical Trends in Intramolecular [2 + 2] Photocycloadditions of 6-(Prop-2-enyl)cyclohex-2-enones and 5-(prop-2-enyl)cyclopent-2-enones*, by Giuliano Cruciani et al..

The said Article is deemed to anticipate applicant's claims. In the alternative, if applicant's specifically disclosed compounds are not directly disclosed, they would have been obvious since they fall within the generic broad disclosure of ketone compounds taught by the reference. Furthermore, applicant's claims are deemed to be obvious over the generic disclosure of the document's method of making said ketone compounds.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant cited Article XP-002254318 entitled: *Regiochemical Trends in Intramolecular [2 + 2] Photocycloadditions of 6-(Prop-2-enyl)cyclohex-2-enones and 5-(prop-2-enyl)cyclopent-2-enones*, by Giuliano Cruciani et al..

The article has been described above and differs from applicant's claimed invention in that there is not a direct disclosure to the use of said compounds to make flavor or fragrance compositions as set forth in claims 12-14.

It would have been obvious to one having ordinary skill in the art to use the disclosed ketones in flavour or fragrance compositions since such is deemed to be at once envisaged since these types of ketones are well known in the art to be highly aromatic, and ketones in general are well known fragrances.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are indefinite because they use the term “use” in the preamble of claims which is not a proper statutory class of invention. These claims also lack a definitive method step. As such, these claims are being withdrawn from further consideration.

Examiner Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

/Joseph D. Anthony/
Primary Examiner, Art Unit 1796
4/28/08